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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,442	02/10/2004	Moses Rodriguez	2609/60726-AZ/JPW/GJG/DJK	3701

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John P. White  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER

WANG, CHANG YU

ART UNIT	PAPER NUMBER
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1649

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/776,442

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Chang-Yu Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-42, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 19-42 and 44-45 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 19-27, drawn to a method of stimulating remyelination comprising administering an antibody against to glatiramer acetate, classified in for example class 435, subclass 7.21.
  - II. Claims 28-42, drawn to a method of treating a subject suffering from a disease associated with demyelination comprising administering an antibody against glatiramer acetate, classified in for example class 514, subclass 2.
  - III. Claim 44, drawn to a method of treating a subject suffering from a disease associated with demyelination comprising administering glatiramer acetate to the subject, classified in for example class 514, subclass 2.
  - IV. Claim 45, drawn to a method of stimulating proliferation of lymphocytes, classified in for example class 435, subclass 7.21.
  
2. The inventions are distinct, each from the other because of the following reasons: Inventions I, II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the materials, steps and outcomes are different among these different Inventions. For example, the glatiramer acetate used in the Group III is not required in

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the Groups I, II and IV. The lymphocytes used in the Group IV are not required in the Groups I-III. The methods of treating a subject in Groups II and III are not required in the Groups I and IV. Thus, Inventions I, II, III and IV are patentably distinct.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). In order to be fully responsive, Applicant is required to elect a single group from designated Groups I-IV to which the claims will be restricted, even though the requirement is traversed. The subject matter for examination will be restricted to the extent of the subject matter of the elected group.

#### ***Election of Species***

5. This application contains claims directed to the following patentably distinct species of the claimed inventions:

6. i. The species of the disease associated with demyelination of the central nervous system as recited in Groups II and IV are as follows:

A) acute disseminated encephalomyelitis, B) transverse myelitis, C) demyelinating genetic diseases, D) spinal cord injury, E) virus-induced demyelination, F) Progressive Multifocal Leukoencephalopathy, G) Human

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Lymphotropic T-cell Virus I (HTLV)-associated myelopathy, or E) nutritional metabolic disorders.

7. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. The claims are deemed to correspond to the species listed above in the following manner:

If Groups II or IV is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for the disease associated with demyelination of the central nervous system selected from group i for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 28 and 44 are generic.

11. The species listed above are patentably distinct for the following reasons:

12. These species are distinct because they are different diseases. The etiology and potential molecular mechanisms contributed to these pathological conditions are different. For example, the pathology and etiologies of neurological injury are very different from those of nutritional metabolic disorders. The patient populations in each pathological condition or disease are also very distinct. The health status, the medication, the diagnosis, and the physiological condition in patients with neural injury are very different from those with nutritional metabolic disorders. It requires different diagnoses, equipments, steps and treatments for these different groups of patients. Therefore, each species of diseases is patentably distinct.

13. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). In order to be fully responsive, Applicant is required to elect a single group from designated Groups I-IV and a single species from groups i that are applicable as set forth above to which the claims will be restricted, even though the

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requirement is traversed. The subject matter for examination will be restricted to the extent of the subject matter of the elected group and species.

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

15. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

16. Papers relating to this application may be submitted to Technology Center 1600, Group 1649 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (571) 273-8300.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chang-Yu Wang, Ph.D. whose telephone number is (571) 272-4521. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, Ph.D., can be reached at (571) 272-0867.

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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CYW

November 28, 2005

  
JANET L. ANDRES  
SUPERVISORY PATENT EXAMINER